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The time period for reply, if any, is set in the attached communication.

RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROSHI MIKITANI, SHINNOSUKE HONJO,
and TOMOMI HATANOU

Appeal 2010-012494
Application 09/653,163
Technology Center 3600

Oral Hearing Held: Wednesday, February 22, 2012

19 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and JOSEPH A.
20 FISCHETTI, *Administrative Patent Judges*

22 ON BEHALF OF THE APPELLANT:

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Appeal 2010-012494
Application 09/653,163

1 *The above-entitled matter came on for hearing on Wednesday,*
2 *February 22, 2012, commencing at 9:21 a.m., at the U.S. Patent and*
3 *Trademark Office, 600 Dulany Street, 9th Floor, Hearing Room A,*
4 *Alexandria, Virginia, before Jon Hundley, notary public.*

5 JUDGE CRAWFORD: Good morning.

6 MR. DUTTON: Good morning.

7 JUDGE CRAWFORD: You can begin whenever you're ready.

8 MR. DUTTON: Thank you, Your Honors. May it please the court.

9 My name is Brian Dutton. I'm counsel for Sony Corporation, the appellant
10 before this court today.

11 The following issue before this court is whether the Examiner erred in
12 rejecting the claims presently on appeal. We believe that our appeal briefs
13 and reply briefs show that the Examiner's findings are unsupported by
14 substantial evidence and are erroneous as a result.

15 Throughout my remarks, I will refer to the Examiner's answer of June
16 28, 2010. Beginning on page 6 of the Examiner's answer, the Examiner erred
17 in rejecting Claims 1, 10, 17, and 21 under 35 USC 112, second paragraph.

18 Here, page 5 of the Examiner's answer erroneously concludes that the
19 appellant has failed to adequately describe sufficient structure for performing
20 the claimed functions of Claim 1, as well as Claims 10, 17, and 21, which
21 contain similar limitations.

22 In response to that assertion, we wish to first point the court to this case
23 In Re Aoyama, which was recently decided in August of this year, where the
24 Federal Circuit has set out a two-step test construing means plus function
25 claims.

1 The citation for In Re Aoyama is 99 USPQ 2nd 136, and within that
2 decision, the first step, according to the Aoyama test in construing means plus
3 function claims is to define the particular function of the claim limitation.

4 Referring to Claim 1 on appeal, for example, page 14 of our reply brief
5 identifies the functions of storing, limiting the customers stored in the storing
6 means, uniquely allocating a reply electronic mail address, sending a first
7 electronic mail, recognizing an application for the lottery, and notifying each
8 one of said participants.

9 The second step in construing means plus function claims pursuant to
10 the Aoyama test is to identify the corresponding structure for that function in
11 the specification.

12 Page 13 of our reply brief refers to Figures 4 and 5 of the specification,
13 which depict structures -- structure of the host 1 -- I'm sorry -- the host 122.

14 Likewise, the host 122 is also depicted within the lottery system of
15 Figure 3.

16 In applying the two-step test set out in Aoyama, the structure of Claims
17 1, 10, 17, and 21 is readily apparent to a skilled artisan. As a consequence,
18 we believe that the Examiner erred in rejecting the claims under 35 USC 112,
19 second paragraph.

20 Beginning on page 8 of the Examiner's answer, the Examiner erred in
21 rejecting Claims 1 through 4, 6, 8 through 13, and 16 through 22 under 35
22 U.S.C. § 103 as being unpatentable over Strandberg in view of Wendkos.

23 I'm going to refer to my remarks for the independent claims for the sake
24 of time.

25 JUDGE FISCETTI: Excuse me, Counsel.

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1 MR. DUTTON: Yes.

2 JUDGE FISCHETTI: I regress for a second.

3 MR. DUTTON: Yes.

4 JUDGE FISCHETTI: Do your drawings -- I'm looking at a lot of
5 Japanese writing in them. Are there English translations of these?

6 MR. DUTTON: Yes. We will be submitting the English translations,
7 but they are not presently in the file history.

8 JUDGE FISCHETTI: Because you're relying on them for your basis
9 for overcoming the 112.

10 MR. DUTTON: Yes.

11 JUDGE FISCHETTI: It's a little hard for me right now.

12 MR. DUTTON: Well, by looking at -- not paying attention to the
13 Japanese --

14 JUDGE FISCHETTI: Okay.

15 MR. DUTTON: Just paying strict attention to the handwritten portions

16 --

17 JUDGE FISCHETTI: Okay.

18 MR. DUTTON: -- that were filed along with the application papers as
19 originally filed --

20 JUDGE FISCHETTI: All right.

21 MR. DUTTON: -- you can see, for example, in Figure 4 that there is a
22 host 122.

23 JUDGE FISCHETTI: Okay.

24 MR. DUTTON: Also, there are steps S-202, S-208, S-210, and so
25 forth.

1 JUDGE FISCHETTI: All right.

2 MR. DUTTON: Now, going to the specification where it describes the
3 corresponding meetings and relationships with those steps, when pairing the
4 two together, it's easy to see that you have a host and the host does certain
5 things along that particular line.

6 JUDGE FISCHETTI: Okay. Thank you.

7 MR. DUTTON: Yes, sir.

8 The claims on appeal include uniquely allocating a reply electronic
9 mail address to each of the specified participants.

10 JUDGE FETTING: Counsel, you really have two sets of claims, don't
11 you, one directed towards electronic mail and others directed towards a URL
12 of a web page?

13 MR. DUTTON: A URL?

14 JUDGE FETTING: Claim 10. Claim 10 would be using a URL of a
15 web page rather than email, right?

16 (Pause.)

17 MR. DUTTON: Yes, that's correct.

18 JUDGE FETTING: So, it just seems as though you have two sets of
19 claims, and so, I appreciate the distinction of how you're distinguishing of the
20 art in each of those cases.

21 MR. DUTTON: Okay. Thank you. We will definitely address that.

22 I guess regarding the electronic mail in this particular instance, as we've
23 noted in our briefs, the Wendkos reference is silent as to the presence of
24 electronic mail. Instead, the Examiner has referred to Strandberg for this
25 feature.

1 On pages 19 through 21 of our reply brief, we have provided the
2 detailed analysis as to why the claimed reply electronic address is absent from
3 within Strandberg.

4 Specifically, in Strandberg, the interested party accesses the web page
5 in paragraph 20, and it refers back to the web page. Instead of identifying a
6 reply electronic email address, the Examiner refers to the unique ID within
7 Strandberg, and within that unique ID, that unique ID is not part of an email
8 address.

9 JUDGE FETTING: The Examiner says -- well, what's the difference?
10 So, I guess that -- so, I guess that's the question to ask you.

11 What's the difference between simply having the -- the unique ID be in
12 the text of the email versus being part of the email address? It's just two
13 different ways of getting to the same result, isn't it?

14 MR. DUTTON: Thank you for the question. Thank you very much.

15 Well, the answer to that -- and using the structure of the -- attaching the
16 reply email address with the unique ID -- when you send the return email
17 back to the host, you will send it back not -- you will send it back to a
18 particular email address, and that email address is the email address that has
19 been established with the message that has been sent to the participant, but in
20 doing so, when the email address returns, it is not sent to a common email
21 address but is sent to multiple email addresses, and depending on the email
22 address which has been received, that will determine who the participant is
23 and whether they're a winner and all sorts of other distinguishing factors, and
24 so, that's one of the key differences between what the applicant is doing and
25 what Strandberg is doing.

1 Strandberg has more of a focus where you're sending the email, the
2 return email goes to a common email.

3 So, our reading of Strandberg seems to be that multiple participants are
4 sending their messages back to the same email address, whereas in our
5 invention, multiple participants are sending the email messages back to
6 individualized email addresses, and depending on the email address, will
7 determine who that participant is, and so that that's the distinction that we do
8 not see within in Strandberg.

9 The claims on appeal include sending a first electronic message to each
10 of the participants, the reply electronic message being affixed to the electronic
11 message, and it has its unique access key to the participants.

12 In this regard, the specification for the claims on appeal defines the
13 participant in a lottery system as a person who -- to whom the email is sent.

14 Also, the claims include recognizing an application for the lottery from
15 each of the participants by receiving a second email back to the reply
16 electronic mail address, and we have noticed in our briefs Wendkos is silent
17 as the presence of electronic mail, and to account for the deficiencies in
18 Wendkos, the Examiner relies upon Strandberg for these features, and
19 particularly, the Examiner contends that the purpose of allocating the unique
20 ID in Strandberg's system is the same as that of the unique email address in
21 the applicant's invention, and of course, we've taken exception to that
22 characterization, noting that our claim language is specific as far as what it
23 actually says.

24 Here, however, the Examiner has failed to identify any objective
25 evidence that the skilled artisan would have recognized to establish an

1 equivalency between a unique ID of Strandberg and an address for an
2 electronic mail.

3 Thus, the Examiner has erred in concluding that the combination of
4 Strandberg and Wendkos teaches recognizing an application for lottery from
5 each of the participants by receiving a second email back to the reply email
6 address.

7 The claims also include notifying each one of the participants who sent
8 back the second email address as a result of the lottery. Page 9 of the
9 Examiner's answer is in agreement as to the absence of this feature from
10 within Strandberg, and regarding Wendkos, a review of that reference reveals
11 an absence to an email address.

12 Thus, again, the Examiner has erred in concluding that the combination
13 teaches notifying one of the participants who sends back a second email
14 address to the reply to the electronic address as a result of the lottery.

15 JUDGE FETTING: So, Counsel, if you could address the distinction in
16 Claim 10 with the URL, as opposed to the email address --

17 MR. DUTTON: Okay.

18 JUDGE FETTING: It seems -- assuming -- just assuming arguendo
19 that we can see a distinction in an email address and having this set that up in
20 advance, it's not necessarily clear that putting a unique number in a URL rises
21 to the same level of distinction as perhaps putting a unique identifier in an
22 email address.

23 (Pause.)

24 MR. DUTTON: Okay. I guess your point is --

25 JUDGE FETTING: I believe it's similarly used in Claim 17.

1 MR. DUTTON: Here's the distinction -- well, especially in Claim 17,
2 you will see that the URLs are different from each other, whereas within
3 Strandberg, you're sending it back to the same URL.

4 JUDGE FETTING: Understood. But in a sense, so what? A URL is
5 just an index. Clearly, the unique key is an index. What difference does it
6 make, you know, whether the index is encoded in the URL or somewhere
7 else? No matter what, you're still going to have to index into some set of data.
8 I mean, it's just a question of where you put it. It's not clear that it arises to
9 the level of a patentable distinction.

10 MR. DUTTON: One of the items, though, is that when you're sending
11 your return back to distinct URLs, it does streamline the processing, as we've
12 shown in, I guess, our Figures 3 and 4, especially, with server B, and how the
13 process goes when you're -- when the applicant is -- when the participant is
14 responding to the email.

15 They're sending out the -- by accessing the particular URL at this point,
16 they can have that immediate result or immediate confirmation as to whether
17 or not they are a winner or a loser. So, as opposed to just going into a
18 common email situation which -- which the Strandberg does, our method --
19 our method and apparatus provides the applicant instant notification because
20 of the particular URL and the particular web page that is being addressed.

21 So, it just -- it helps with the processing and speed, so you're not going
22 through a common website, and again, you have various distinctions between
23 who the winners are and who the losers are by the particular web pages that
24 they're accessing.

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1 So, winners are not accessing the loser URLs, and the losers are not
2 accessing the winner URLs.

3 So, you don't -- you do not have that particular feature within -- within
4 Strandberg. Everything is going to a common point.

5 JUDGE FETTING: Thank you.

6 MR. DUTTON: Yes.

7 JUDGE FETTING: I have no further questions.

8 MR. DUTTON: Okay. Well thank you very much. That concludes
9 my remarks. And again, thank you for the very good questions.

10 (Whereupon, at 9:39 a.m., the proceedings were concluded.)

11